

## **REMARKS**

Claims 46-72 appear in this application for the Examiner's review and consideration. Claim 46 has been amended to clarify the claimed invention. In particular, claim 46 now recites more clearly that the phrase "the first" (cl. 46, ln 10) is referring to the first shore D of the material of the inner cover layer.

As no new matter has been added, Applicants respectfully request entry of these amendments at this time.

### ***The Examiner Interview***

Applicants thank the Examiner for the courtesies extended to Applicants' representatives during the in-person interview conducted on April 3, 2002. As explained during the interview, the commercial success of the Pro V1 star indicates that the pending claims are not obvious.

### ***The Revocation and Power of Attorney***

Applicants submit herewith a Revocation and Power of Attorney indicating the change in representation of this case. Applicants request confirmation that the Revocation and Power of Attorney has been received and that future correspondence will be directed to Applicants' new representatives.

## **THE REJECTIONS UNDER 35 USC § 103**

### ***The Rejection Based on Melvin '562 and Sullivan '870***

The Examiner rejected all of the pending claims as being unpatentable over U.S. Patent No. 5,779,562 to Melvin in view of U.S. Patent No. 5,971,870 to Sullivan for the reasons provided on pages 2-5 of the Office Action.

In particular, the Examiner principally relied upon Melvin '562, but acknowledged, however, that Melvin '562 does not disclose all of the features recited in the claims. In particular, the Examiner stated that Melvin '562 lacks any teaching regarding casting an outer cover layer. (See Office Action at 3.) The Examiner then relied upon Sullivan '870 to state that it would have been obvious to cast an outer cover around the golf ball taught by Melvin '562. Applicants respectfully traverse on two grounds.

First, it is well-settled law that evidence of secondary considerations weighing against obviousness (*e.g.*, unexpected results, commercial success, long-felt but unsolved needs, etc.) can rebut an Examiner's obviousness rejection. *See, e.g., Graham v. John Deere Co.*, 383

U.S. 1 (1966); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). *See also*, MPEP § 716.01(a)-(c) and 716.03(a)-(b).

Here, the commercial success of the Pro V1 star demonstrates that the claimed invention is not obvious. As discussed during the interview, Applicants have attached herewith a Declaration of Herbert C. Boehm under 37 CFR 1.132. The declaration explains first that there is a clear nexus between the commercial success and the claimed invention because the Pro V1 star is manufactured in accordance with all of the steps recited in each of the pending independent claims. (Boehm decl. at ¶5.)

As soon as the Pro V1 star became available to professional golfers late last year, it immediately became one of the most popular balls selected in PGA Tour events. (Boehm decl. at ¶10.) The popularity of the Pro V1 star by professional golfers is not due to marketing, advertising, or promotion, as Acushnet Company does not make any attempt to influence a player's golf ball selection for these reasons. (Boehm decl. at ¶7.) Rather, its success can only be attributed to objective principles relating to the ball's performance. (*Id.*) Case law has supported findings of non-obvious in situations such as this where a product achieved a large market share because of the merit of the claimed invention. *See, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367 (Fed. Cir. 1986).

This evidence of commercial success strongly weighs against a finding of obviousness. For this reason, Applicants respectfully request the Examiner reconsider and withdraw the obviousness rejection.

Second, Applicants note that the earliest date that can be afforded Sullivan '870 is its filing date in late November 1997, whereas the present case claims priority to U.S. Patent 5,885,172, which was filed in May 1997. The presently pending independent claims are supported by the disclosure of the '172 patent, and therefore are entitled to this earlier priority date. (*See, e.g.,* Fig. 1, col. 4, line 63 to col. 5, line 6, and col. 7, lines 35-40.) Because the present claims are entitled to the filing date of this parent application, Sullivan '870 is not prior art. U.S. Patent No. 5,989,136 to Renard also is not prior art because its filing date was in October 1997. Moreover, U.S. Patent 5,688,191 to Cavallaro is removed from consideration by the Examiner under 35 U.S.C. § 103(c) since both that patent and this application are commonly assigned to the same entity. Thus, Applicants respectfully submit that the Examiner can not rely upon Sullivan '870, Renard '136, or Cavallaro '191 to reject the pending independent claims.

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In light of the remarks above, Applicants respectfully submit that the obviousness rejections have been overcome. Applicants therefore respectfully request reconsideration and withdrawal of the rejections.

### CONCLUSION

Applicants believe that all of the pending claims are in condition for allowance. If the Examiner believes that this response does not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

No fee is believed to be due at this time. Should any fee be required, however, please charge such fee to Swidler Berlin Shereff Friedman, LLP Deposit Account No. 195127, Order No. 20002.0052.

Respectfully submitted,  
SWIDLER BERLIN SHEREFF FRIEDMAN, LLP

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By: 

John P. Mulgrew, Registration No. 47,809  
SWIDLER BERLIN SHEREFF FRIEDMAN, LLP  
3000 K Street, NW, Suite 300  
Washington, D.C. 20007  
(202) 424-7756 Telephone  
(202) 295-8478 Facsimile

**APPENDIX A**  
**MARKED UP VERSION OF THE AMENDED CLAIMS**

Please amend the claims as follows:

46. (Amended) A method of forming a golf ball comprising the steps of:  
forming a core comprising:  
a solid center made from a first rubber based material;  
a solid outer layer made from a second rubber based material having different physical properties from said first rubber based material;  
forming an inner cover layer made from a material having a first shore D hardness from about 65 to about 74 shore D and having an outer diameter of at least 1.6 inches;  
casting an outer cover layer made from a material having a second shore D hardness less than the first shore D hardness of the material of the inner cover layer.

# EXHIBIT A

PGA Tour 2002 through 1/20/02

Tourney	Date	Titleist Pro V1	Titleist Star	Titleist Diamond	Callaway CTU 30 Red	Callaway HX Red	Maxfli A 10	D-Stone TP	D-Stone TP LS	B-Stone Tenge U2	Nike TA	Nike TA TW	Field
Mercedes	1/6/02	18	3	8	0	0	2	1	2	1	1	2	32
Sony Open	1/13/02	60	15	8	12	2	10	0	10	4	7	4	146
Hypo	1/20/02	56	14	6	9	3	6	0	6	1	10	4	128
Total		134	32	14	21	5	18	1	18	6	18	10	304
		44.3%	10.5%	4.6%	6.9%	1.4%	5.9%	0.3%	5.9%	2.0%	5.9%	3.3%	

PGA Tour 2001: 9/20 - 10/28/01

Tourney	Date	Titleist Pro V1	Titleist Star	Titleist Diamond	Callaway CTU 30 Red	Callaway Rufe 35 Red	Callaway HX Red	Maxfli A 10	D-Stone TP	D-Stone TP LS	B-Stone Tenge U2	Nike TA	Nike TA TW	Field
PA Classic	9/23/01	64	23	4	0	12	0	8	3	6	0	14	6	138
Texas Open	9/30/01	69	18	5	0	4	6	7	3	7	0	13	5	156
Alcatraz	10/7/01	74	19	3	0	6	1	7	3	9	0	13	4	156
Las Vegas	10/14/01	54	17	8	2	5	3	7	3	9	0	15	5	144
Waco	10/21/01	53	20	7	6	1	0	9	3	9	1	13	8	144
Bridg Chell	10/28/01	55	18	5	4	1	1	3	3	8	2	15	5	132
TOUR Champ	11/4/01	18	2	1	0	0	0	1	0	0	0	2	1	20
Southern Farm	11/4/01	48	19	5	2	1	1	6	3	6	0	12	7	120
Total		405	136	38	14	30	12	48	21	54	3	97	41	1839
		41.9%	13.1%	3.7%	1.3%	2.9%	1.3%	4.6%	1.0%	5.2%	0.3%	9.3%	3.9%	